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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

INVENTOR(S) : David Neff
TITLE : **BONDED PARTICLE FILTERS**
APPLICATION NO. : 10/659,817
FILED : September 11, 2003
CONFIRMATION NO. : 5262
EXAMINER : Scott R. Kastler
ART UNIT : 1742
LAST OFFICE ACTION : November 3, 2005
ATTORNEY DOCKET NO. : MLCZ 2 00106

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief-Patents
Commissioner for Patents
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This Reply Brief is being filed within two months of the Examiner's Answer. For the sake of brevity, Appellant only responds to a few of the Examiner's arguments. This should not be taken as an admission with regard to the propriety of the Examiner's arguments raised in his Answer.

REPLY TO EXAMINER'S POINTS OF ARGUMENT WITH RESPECT TO MPEP 716.01 (c) II

The Examiner's misunderstanding of *Dailey* in rejecting claims 1-5, 11-17 and 19 resulted in a mistaken reliance on MPEP 716.01 (c) II in the Response to Arguments section of his Answer. The Examiner's reliance on MPEP 2144.04 IV B and *In re Dailey*, 149 USPQ 47 at page 3 of the Examiner's answer is misplaced. At page 3 of his Answer, the Examiner states that "absent any demonstrated new or unexpected results arising therefrom, motivation to alter the shape or configuration of the apparatus or component already taught by the applied prior art, would have been a modification obvious to one of ordinary skill in the art at the time the invention was made." The court in *Dailey* did not require a demonstration of new or unexpected results. Instead, the court in *Dailey* held that Appellants had presented no argument that the particular configuration of their apparatus is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious. See *Dailey*, 149 USPQ at 50.

The Examiner's misunderstanding of *Dailey* resulted in the incorrect requirement that Applicant must demonstrate a new or unexpected result from the use of a filter configuration including a beveled end. See page 4 of Examiner's Answer, first two paragraphs under (10) Response to Argument. Appellant never argued new and/or unexpected results in the Appeal Brief; instead, Appellant argued the significance of the claimed structure with reference to U.S. Pat. No. 5,370,171, which was discussed in Applicant's specification. Such an argument is in accordance with *Dailey*.

The Examiner's misunderstanding of *Dailey* also resulted in the incorrect requirement that Applicant demonstrate, by providing evidence supported in declaration form, of a new or unexpected result from the use of a filter configuration including a beveled end. See page 4 of Examiner's Answer, second paragraph under (10) Response to Argument. The Examiner states that arguments of counsel cannot take the place of evidence in the record. Page 4, Examiner's Answer.

In his Answer, the Examiner draws a distinction between argument and evidence, which may be proper, evidence seemingly requiring a declaration. Nevertheless, even though MPEP 2144.04 IV B states that the court in *Dailey* held that the configuration was a matter of design choice absent persuasive evidence, the court in *Dailey* made no mention of evidence¹. Rather the court in *Dailey* held that Appellants had failed to present a sufficient argument. 149 USPQ at 50 (emphasis added). In the instant case, Appellant has provided sufficient argument, as well as discussion in the specification (see paragraph [0014] “The shape chosen is one that can maximize the surface area of the filter[.]”) to support that the claimed configuration is significant.

REPLY TO EXAMINER’S POINTS OF ARGUMENT WITH RESPECT TO STANKIEWICZ ENVISIONING THE USE OF FILTER ELEMENTS IN ANY DESIRED MOLTEN METAL TRANSPORT SYSTEM

The Examiner’s argument with respect to claim 13 that “Stankewicz (col. 3 lines 24-27 for example) envisions the use of it’s recited filter elements in any desired molten metal transport system, which includes dosing tubes” (Page 5, Examiner’s Answer) is incorrect. At col. 3, lines 24-27 Stankewicz states “The assembly is susceptible of being mounted into a molten metal holding furnace or other means of molten metal transport such that the molten metal flow is introduced to the exterior of the close-ended cylindrical elements and the upper surface of the plate element.” This does not suggest attaching a filter to a dosing tube.

In the sentence preceding the sentence at col. 3, lines 24-27, Stankewicz states that the filter element extends vertically above the elevation of the sealing plate. See col. 3, lines 17-24. In other words, the filter device in Stankewicz relies on gravity to work. In contrast a dosing tube typically relies on a vacuum to work. Stankewicz goes on to state “[t]he molten metal flows through the porous ceramic material of the cylindrical elements and preferably through the sealing plate element to be further flowed downstream, ultimately to the associated

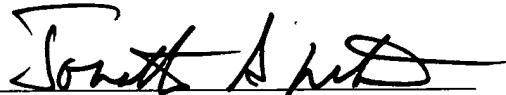
¹ The opinion does not include the word “evidence.”

casting molds.” Col. 3, lines 31-34. After considering this sentence, one skilled in the art would be led to think that the filter disclosed in Stankiewicz is upstream from and not attached to the dosing tube, which delivers molten metal to a casting mold, as opposed to being attached to the dosing tube. Furthermore, each of the many different embodiments disclosed in Stankiewicz discloses the filter element mounted to a molten metal holding furnace, as opposed to attached to a dosing tube.

CONCLUSION

In view of Appellant’s Appeal Brief and the arguments presented above, Appellant respectfully submits that claims 1-5, 11-17, and 19 are in condition for allowance. Therefore, Appellant requests that the Board of Patent Appeals and Interferences reverse each rejection made by the Examiner.

Respectfully submitted,



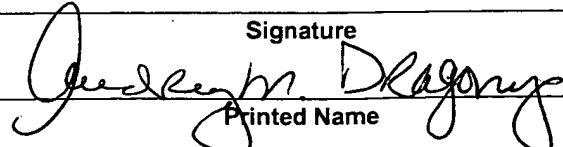
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CERTIFICATE OF MAILING OR TRANSMISSION

Under 37 C.F.R. § 1.8, I certify that this Reply Brief Under 37 C.F.R. § 41.41 is being

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